



UNITED STATES PATENT AND TRADEMARK OFFICE

UNITED STATES DEPARTMENT OF COMMERCE
United States Patent and Trademark Office
Address: COMMISSIONER FOR PATENTS
P.O. Box 1450
Alexandria, Virginia 22313-1450
www.uspto.gov

APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
-----------------	-------------	----------------------	---------------------	------------------

10/782,312

02/19/2004

Cyril Henry Putnam Brookes

36461

7622

116 7590 03/17/2008

PEARNE & GORDON LLP
1801 EAST 9TH STREET
SUITE 1200
CLEVELAND, OH 44114-3108

EXAMINER

TARAE, CATHERINE MICHELLE

ART UNIT

PAPER NUMBER

3623

MAIL DATE

DELIVERY MODE

03/17/2008

PAPER

Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Office Action Summary	Application No. 10/782,312	Applicant(s) PUTNAM BROOKES, CYRIL HENRY	
	Examiner C. Michelle Tarae	Art Unit 3623	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --
Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 19 February 2004.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-9 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-9 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☒ All b) ☐ Some * c) ☐ None of:
1. ☒ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- * See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|--|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | 5) <input type="checkbox"/> Notice of Informal Patent Application |
| 3) <input checked="" type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08)
Paper No(s)/Mail Date <u>9/13/04</u> . | 6) <input type="checkbox"/> Other: _____ |

DETAILED ACTION

1. The following is a Non-Final Office Action in response to the communication received on February 19, 2004. Claims 1-9 are now pending in this application.

Claim Rejections - 35 USC § 112

2. The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

3. Claims 1-9 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

Claims 1 and 8 recite, likely to be required, which renders the claims indefinite. The phrase "likely to be required" is not defined by the claim, the specification does not provide a standard for ascertaining the requisite degree, and one of ordinary skill in the art would not be reasonably apprised of the scope of the invention. Since the scope of having something likely to be required is not clear, the claim is indefinite.

Correction is required.

Claim Rejections - 35 USC § 102

4. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

5. Claims 1-9 are rejected under 35 U.S.C. 102(e) as being anticipated by Young et al. (U.S. 2003/0018487).

As per claim 1, Young et al. discloses an executive information requirements specification system for utilisation in conjunction with the Business Intelligence operations of an organisation, said system including:

at least one of four interactive modules that control the desirable path for interviewing an executive to determine a BI system specification, each of said modules storing information relevant to a project or an organisation, the modules including:

(a) a first module eliciting and storing information requirements related to the operational status of the organization (paragraph 80; Figure 4; A self-assessment module receives information from a user regarding operations of a business.);

(b) a second module eliciting and storing information requirements about the relevant acceptability of the operational status of the organization (Figure 3 shows a acceptability of various operational requirements in terms of a percentage.);

(c) a third module eliciting and storing information requirements derived from forecasting and exception analysis models of the organization (paragraphs 250, 253 and 267); and

(d) a fourth module eliciting and storing information and model requirements likely to be required should a problem be identified with the organization (paragraphs 247 and 335-349; Questions eliciting the handling of various employee issues and potential problems are asked, where the questions are used to address areas where requirements should be implemented in order to achieve a desired level of operation.).

As per claim 2, Young et al. discloses a system as claimed in claim 1 wherein each of said modules includes a number of sub-modules eliciting and storing information relevant to the module for interaction with or by a user including information quantifying the value of specified requirements to the executive and the adequacy of current implementations of the requirements in a BI system (if any) (paragraphs 173-175; Figure 8; An organization is scored on various criteria related to operational performance.).

As per claim 3, Young et al. discloses a system as claimed in claim 2 wherein said first module includes a series of submodules directed to at least one of the project or organisation key performance indicators and customer feedback (paragraphs 359, 676).

As per claim 4, Young et al. discloses a system as claimed in claim 2 wherein said second module includes a series of submodules directed to at least one of many possible benchmarks that the organization has sought to achieve, relative performance

measurements, exceptional situations and market feedback (paragraphs 188 and 202-204).

As per claim 5, Young et al. discloses a system as claimed in claim 2 wherein said third module includes a series of submodules directed to significant changes in at least one of trends established in operational key time series, forecasting model results, and verbal reports of unexpected events in the marketplace (paragraphs 40, 215, 244, 250; Figure 5; The self-assessment allows companies to address and adapt to significant changes relating to operational performance.).

As per claim 6, Young et al. discloses a system as claimed in claim 2 wherein said fourth module includes a series of submodules directed to at least one of tools allowing for fast diagnosis of problems and to ensuring data availability for answering anticipated questions (paragraphs 247 and 714-724; The self assessment tool may be used as a diagnostic tool.).

As per claim 7, Young et al. discloses a system as claimed in claim 1 wherein said system is implemented via an internet browser environment or via one, or a network of, personal computers (paragraph 75).

Claims 8 and 9 recite limitations similar to those already rejected above. Therefore, claims 8 and 9 are rejected on the same basis as claims 8 and 9 above.

Conclusion

6. The prior art made of record and not relied upon is considered pertinent to applicant's disclosure.

- Strutt et al. (U.S. 2002/0133368) discusses analyzing business activities of an organization.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to C. Michelle Tarae whose telephone number is 571-272-6727. The examiner can normally be reached Monday – Friday from 8:30am to 5:30pm.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Tariq Hafiz, can be reached at 571-272-6729.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

/C. Michelle Tarae/
Primary Examiner, Art Unit 3623

March 3, 2008